

third means for controlling the first means and the second means;
wherein the third means controls the second means so as to send data corresponding to the
sending operation of the first means, and

wherein the sending operation of the second means indicates that the first means has
executed transmission of the facsimile data over the first communication network to said
recipient, prior to the recipient accessing said second communication network.

REMARKS

The above Amendment and following remarks are responsive to the points raised in the
Office Action dated June 12, 2002.

Upon entry of this Amendment, Claims 1-25 are all the claims pending in the application.
Claims 1, 2, 5, 6, 9-11, 20 and 22 will have been amended. The attachment to this Amendment
shows the amendments made to claims 1, 2, 5, 6, 9-11, 20 and 22 by bracketing the text that has
been deleted and underlining the text that has been added. No new matter has been introduced
by this Amendment. Entry and consideration of this Amendment are respectfully requested.
The Applicant respectfully requests entry of this Amendment, favorable reconsideration of this
case, and early issuance of a Notice of Allowance.

STATUS OF CLAIMS

Claims 2 and 10 are objected to for minor informalities. Claims 1 and 9 are rejected
under 35 U.S.C. § 102(e) as being anticipated by Williams et al. (USP No. 6,192,045, hereafter
Williams). Additionally, claims 20-25 stand rejected under 35 U.S.C. § 102(e) as being
anticipated by Mordowitz et al. (USP No. 6,011,794, hereafter Mordowitz). Claims 2, 4 and 10

stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mordowitz in view of Kulakowski (WIPO Publ. No. WO97/10668). Claims 5-8 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cooper et al. (USP No. 6,052,442, hereafter Cooper) in view of Ho et al. (USP No. 5,805,298, hereafter Ho). Claims 12-13, 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mordowitz in view of Williams further in view of Bloomfield (USP No. 6,025,931, hereafter Bloomfield). Claims 14-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mordowitz in view of Williams further in view of Bloomfield and yet further in view of Bobo, II (USP No. 5,675,507, hereafter Bobo). Finally, claims 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Mordowitz in view of Williams further in view of Bloomfield and yet further in view of Wegner et al. (USP No. 5,712,907, hereafter Wegner). Accordingly, we propose the following for responding to the above rejections.

RESPONSE TO OBJECTION OF CLAIMS 2 AND 10

Claims 2 and 10 are objected to for informalities. Specifically, the Examiner objects to the claims for the use of the acronym "POP." Accordingly, Applicants have herein amended claims 2 and 10 to read "POP (Post Office Protocol)" as suggested by the Examiner. The objection to claims 2 and 10 are now overcome.

RESPONSE TO THE REJECTION UNDER 35 U.S.C. §102

Claims 1 and 9 are rejected under 35 U.S.C. § 102(e) as being anticipated by Williams et al. (USP No. 6,192,045, hereafter Williams). Additionally, claims 20-25 stand rejected

under 35 U.S.C. § 102(e) as being anticipated by Mordowitz et al. (USP No. 6,011,794, hereafter Mordowitz).

The present invention, as recited in amended claims 1, 9, 20 and 22, is directed to a notification means or step that notifies a recipient using a PSTN that a facsimile has been sent via the Internet prior to the recipient accessing the Internet. This is a feature not believed to be disclosed by the prior art of record.

Williams discloses a method of dynamically connecting an originating computer to a receiving computer on a dial-up network, such as the Internet. However, although Williams discloses a means for sending a facsimile communication using the Internet, it fails to disclose a notification means that notifies a recipient that a transmitting communication device has already sent a facsimile via the Internet. Instead, in Williams, the communication device is preprogrammed to detect if the incoming call 62 from the LAC 56 is immediately terminated, and connects the facsimile callback device 54 to the Internet so that it is ready to receive a facsimile from the transmitting device. (col. 9, lines 10-20). In fact, it would be impossible for the receiving device to receive such a notification since Williams seems to indicate that the sending device is attached to the Internet after the receiving device. More specifically, after the receiving device is attached to the Internet, the callback device 53 establishes a connection 61 to a local exchange carrier (LEC) 55 by going off-hook. It then transmits signaling tones to LEC 55 corresponding to the phone number of its Internet service provider 57. The sending facsimile 51 is then connected to the Internet and is ready to transmit facsimile data to the receiving device. (col. 9, lines 20-28). To this end, the notification means in Williams merely

indicates to the receiving device that a facsimile transmission via the Internet is desired.

However, nowhere does Williams suggest that the facsimile callback device 54 receives an indication from the transmitting device that the facsimile data has been sent, as in the present invention.

Mordowitz is directed to an Internet related accessory that enables a party to establish a long distance telephone connection to the Internet. (see Abstract). In Mordowitz, a telephone call between parties can be connected over a conventional calling line 12, 13 or over the Internet via an Internet service provider 11. However, nowhere does Mordowitz disclose notifying a recipient that data has been sent over the Internet.

Therefore, claims 1, 9, 20 and 22 are believed to be distinguishable over Williams and Mordowitz at least for this reason. Additionally, claims 3, 21, and 23-25 are also believed to be distinguishable over the above combination based on their dependency from claims 1, 20 and 22, respectively.

RESPONSE TO THE REJECTION UNDER 35 U.S.C. §103

In the Office Action, claims 2, 4 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mordowitz in view of Kulakowski (WIPO Publ. No. WO97/10668). Claims 5-8 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cooper et al. (USP No. 6,052,442, hereafter Cooper) in view of Ho et al. (USP No. 5,805,298, hereafter Ho). Claims 12-13, 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mordowitz in view of Williams further in view of Bloomfield (USP No. 6,025,931, hereafter Bloomfield). Claims 14-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over

Mordowitz in view of Williams further in view of Bloomfield and yet further in view of Bobo, II (USP No. 5,675,507, hereafter Bobo). Finally, claims 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Mordowitz in view of Williams further in view of Bloomfield and yet further in view of Wegner et al. (USP No. 5,712,907, hereafter Wegner).

The present invention, as recited in amended claims 1, 2, 5, 9-11, 20 and 22 is directed to a communication apparatus that the recipient of a facsimile transmission receives a notification or indication via PSTN that a facsimile has been sent or executed via the Internet prior to the recipient accessing the Internet.

Kulakowski is directed to a device and method for transmitting or receiving a facsimile via a computer network to which the device is connected. Specifically, the device establishes a telephone connection via PSTN with a computer on a network, such as through an online service provider. The device converts the facsimile of voice data to be transmitted into a suitable e-mail format. The device transmits the e-mail message to a service provider and a service provider sends the e-mail message to a recipient. (Pg. 5, line 9 through pg. 6, line 6). Thus, in Kulakowski there is no notification using the PSTN that a facsimile is being sent via the Internet, let alone an indication that the facsimile has already been sent. Therefore, Kulakowski does not overcome the deficiencies noted above in Mordowitz to render obvious claim 1 from which claim 2 depends or claim 10.

Cooper teaches an integrated answering machine system that checks for electronic mail message by calling a service provider and downloading the message. However, as noted by the Examiner (page 11), Cooper fails to teach notifying a recipient using a PSTN. Thus, Cooper

does not overcome the deficiencies noted above in Williams to render obvious claim 1 from which claim 3 depends. For the same reason, the combination of Mordowitz, Kulakowski and Cooper does not to render obvious claim 4.

Ho is directed to a communication device that transmits and receives information in accordance with both facsimile and electronic mail communication protocols. Specifically, a user wishing to receive e-mail from a remote mailbox presses a start button, enters a destination identifier 402 via keyboard 206 to identify the remote mailbox and presses an e-mail key. The communication device responds by reading the destination identified and attempting to connect to a predetermined Internet access provider, which implements the router 107 of FIG. 1, to establish a SLIP/PPP-type connection. The communications device 416 obtains, in accordance with the POP3 Transfer Protocol, from the remote mailbox, data indicative of the e-mail box and displays such data on the display. (col. 7, line 63 through col. 8, line 24). Thus, Ho requires that the communication device be connected to the Internet prior to receiving any type of notification of a facsimile or other type of data communication. (col. 7, line 63 through col. 8, line 24). Therefore, Ho does not overcome the deficiencies noted above in Cooper to render obvious claims 5 and 11. Likewise, claims 6-8 are also believed to be distinguishable over the above combination based on their dependency from claim 5.

Bloomfield is directed to a facsimile-to-e-mail system whereby facsimile communication is sent to a recipient via the Internet. (see Abstract). Specifically, the system bridges two networks by interacting first with the PSTN to transmit telephony signals (a facsimile message to a FEM-GATEWAY); and second interacting with an e-mail network (through the

internet) to deliver the e-mail message to the intended recipient. (col. 2, lines 46-55). In other words, the connection to the PSTN, in Bloomfield, is required for connecting the Internet and sending a facsimile communication. However, the connection to the PSTN is not for any type of notification function, let alone notification that a facsimile communication over the Internet has been sent. Thus, Bloomfield does not overcome the deficiencies noted above in the Williams and Mordowitz to render obvious claims 12, 18 and 19. Likewise, claims 13-17 are also believed to be distinguishable over the above combination based on their dependency from claim 12.

Finally, Bobo is directed to a Message Storage and Deliver System (MSDS) that is connected to telephone lines and receives facsimile messages. (see Abstract). In Bobo, a telephone is directed to a number serviced by the MSDS 10 and then connected to a third party 24. Specifically, a call is routed over an DID trunk 15 to the MSDS 10. The MSDS then routes the call to a third party via the Internet. (Col. 6, line 61 through Col. 7, line 11). Thus, Bobo also fails to teach or suggest the notification feature of the present invention. For this reason, Bobo does not overcome the deficiencies noted in Mordowitz and Bloomfield to render obvious claim 12, from which claims 14 and 16 depend.

CONCLUSION

In view of the above Amendment and remarks, the Applicant respectfully submits that all the pending claims are patentable over the prior art of record and are now in condition for allowance. Accordingly, the Applicant respectfully requests favorable reconsideration of this case and early issuance of a Notice of Allowance.

AUTHORIZATION


The Commissioner is hereby authorized to charge any additional fees which may be required for timely consideration of this Amendment under 37 C.F.R. §§ 1.16 and 1.17, including any extension of time, or credit any overpayment to Deposit Account No. 13-4503, Order No. 1232-4467.

Respectfully submitted,

MORGAN & FINNEGAN, L.L.P.

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By:



Mark D. Pratt
Reg. No.: 45,794
(202) 857-7887 Telephone
(202) 857-7929 Facsimile

CORRESPONDENCE ADDRESS:
Morgan & Finnegan
345 Park Avenue
New York, NY 10154



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Takehiro YOSHIDA

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Examiner: J. Pokrzywa

ATTACHMENT

Commissioner of Patents
Washington, D.C. 20231

SIR,

Please note the following amendments to claims 1-3, 5-6, 8-11, 20, and 22:

IN THE CLAIMS

Please replace claims 1, 2, 5, 6, 9-11, 20 and 22 as follows:

1. (Twice Amended) A communication apparatus comprising:

facsimile communication means for performing facsimile communication through the Internet by dial-up connection; and

notification means for notifying a recipient using a PSTN that a facsimile has been [is being] sent through the Internet, prior to the recipient accessing the Internet.

2. (Thrice Amended) A communication apparatus comprising:

facsimile communication means for performing facsimile communication through the Internet by dial-up connection; and

reception means for, in response to a notification, from a calling party communication apparatus using a PSTN, that the calling party communication apparatus has sent [is sending] a facsimile to the communication apparatus through the Internet, setting up connection to the Internet by dial-up connection and receiving facsimile communication information through the Internet by POP (Post Office Protocol).

5. (Thrice Amended) A communication apparatus capable of facsimile communication through the Internet by dial-up connection, comprising:

display means for, in response to a notification, from a calling party communication apparatus using a PSTN, that the calling party communication apparatus has sent [is sending] a facsimile to the communication apparatus through the Internet, displaying information representing that the calling party communication apparatus has sent [is sending] a facsimile to the communication apparatus through the Internet and station address information of a calling party; and

determination means for determining on the basis of selection by a user whether the communication apparatus is to set up connection to the Internet by dial-up connection to receive facsimile communication information through the Internet by POP (Post Office Protocol).

6. (Twice Amended) The apparatus according to claim 5, further comprising operation mode registration means for registering whether, in response to the notification, dial-up connection is to be immediately performed on the basis of a station address of the calling party communication apparatus to receive the facsimile communication information through the Internet by POP (Post Office Protocol).

9. (Twice Amended) A communication method comprising:
a facsimile communication step of performing facsimile communication through the Internet by dial-up connection; and
a notification step of notifying a recipient using a PSTN that a facsimile has been [is being] sent through the Internet prior to the recipient accessing the Internet.

10. (Thrice Amended) A control method for a communication apparatus comprising:
a facsimile communication step of performing facsimile communication through the Internet by dial-up connection with a station; and
a reception step of, in response to a notification, from a calling party communication apparatus using a PSTN, that the calling party communication apparatus has sent [is sending] a facsimile to the communication apparatus through the Internet, setting up connection to the Internet by dial-up connection and receiving facsimile communication information through the Internet by POP (Post Office Protocol).

11. (Thrice Amended) A control method for a communication apparatus capable of facsimile communication through the Internet by dial-up connection, comprising the steps of:

in response to a notification, from a calling party communication apparatus using a PSTN, that the calling party communication apparatus has sent [is sending] a facsimile to the communication apparatus through the Internet, displaying information representing that the calling party communication apparatus has sent [is sending] a facsimile to the communication apparatus through the Internet and station address information of the calling party communication apparatus; and

determining on the basis of selection by user whether the communication apparatus is to set up connection to the Internet by dial-up connection to receive facsimile communication information through the Internet by POP (Post Office Protocol).

20. (Thrice Amended) A communication apparatus comprising:
transmission means for transmitting facsimile data via the Internet; and
notification means for notifying a recipient, by a method different from that of the transmission means, that the transmission means has executed transmission of the facsimile data via the Internet, prior to the recipient accessing the Internet.

22. (Thrice Amended) A communication apparatus comprising:
first means for sending facsimile data over a first communication network to a recipient;
second means for sending data over a second communication network to said recipient;

third means for controlling the first means and the second means;

wherein the third means controls the second means so as to send data corresponding to the sending operation of the first means, and

wherein the sending operation of the second means indicates that the first means has executed transmission of the facsimile data over the first communication network to said recipient, prior to the recipient accessing said second communication network.